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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/973,815    04/03/98    ZENTGRAF

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BURNS DOANE SWECKER & MATHIS  
PO BOX 1404  
ALEXANDRIA VA 22313-1404

HM12/0719

EXAMINER

WAX, R

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

07/19/99

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/973,815**

Applicant(s)  
**Zentgraf et al.**

Examiner  
**Robert A. Wax**

Group Art Unit  
**1652**



☒ Responsive to communication(s) filed on Jun 10, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-7, 11, and 12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-7, 11, and 12 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☒ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: copy of DE 19521046.8

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim 1, drawn to protein having DNase activity.

Group II, claims 2-6, drawn to DNA, plasmid, transformant and method of making the DNase.

Group III, claim 7, drawn to antibody to the DNase.

Group IV, claim 11, drawn to method for the prevention or treatment of a condition involving apoptosis using the DNase.

Group V, claim 11, drawn to method for the prevention or treatment of a condition involving apoptosis using the antibody to the DNase.

Group VI, claim 11, drawn to method for the prevention or treatment of a condition involving apoptosis using DNA encoding the DNase.

Group VII, claim 12, drawn to method for the diagnosis of a condition involving apoptosis using the DNase.

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Group VIII, claim 12, drawn to method for the diagnosis of a condition involving apoptosis using the antibody to the DNase.

Group IX, claim 12, drawn to method for the diagnosis of a condition involving apoptosis using DNA encoding the DNase.

2. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature shared by all the groups is the protein. The fragment of the protein (claim 1) reads on any other DNase having, for example, an alanine in its sequence. Frenz et al. thus anticipates claim 1. When the special technical feature is taught in the prior art it is proper to hold lack of unity.

3. A telephone call was made to Teresa Rea on June 15, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (703) 308-4216. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy, can be reached on (703) 308-3804. The OFFICIAL fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'Robert A. Wax', is positioned above the printed name and title.

**Robert A. Wax**  
**Primary Examiner**  
**Art Unit 1652**